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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,416	07/17/2003	Wieslawa Wajda	Q76442	9604

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EXAMINER

CAO, PHUONG-THAO

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/620,416	WAJDA, WIESLAWA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Phuong-Thao Cao	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/17/2003</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 1-8 are pending.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "said parameter" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 6, 7, and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claims 6 and 8, “browser” and “composer”, as claimed in claim 6 and 8 respectively, are not tangibly embodied, as they are only software per se. Neither claim includes recitation of any hardware to enable the underlying functionality to occur.

As to claim 7, “an electronic markup language document comprising a markup language control command” is technically a program or software per se. It is not tangibly embodied, since the claim does not include recitation of any hardware.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayes (Pub No US 2002/0152238).

For claim 1, Hayes teaches:

A method of presenting a first electronic document and at least one second electronic document linked to said first electronic document to a user by means of a browser; said first electronic document being a markup language document and comprising a markup language control command adapted to bind said second electronic document into said first electronic document when activated by a user (see e.g., [0002] and [0016]), said method comprising the steps of:

“presenting said first electronic document to a user” (note [0018] for description of providing users with an online HTML document which is displayed by a network browser on a display device for a user (see [0005]));

“upon activation of said control command by the user, embedding at least part of the content of said second electronic document into said first electronic document to create a compound electronic document” (see e.g., [0040] discloses that when a hyperlink is activated, a footnote, known as a linked second document, is embedded on the same Web page [0016] as the text of first document); and

presenting said compound electronic document to the user (see e.g., [0016] and [0043]).

For claim 3, Hayes teaches the method of claim 1 for the reasons above. Hayes also teaches “wherein said control command comprises an attribute specifying the semantic and type of the binding” (see e.g., [0040] and [0041] describe different semantic and types of binding of a hyperlink -- embedded on the same Web page as the text of the document or opening a new

window to present the linked document -- in responding to two different methods of activation, which implies an inherent inclusion of an attribute to specify the semantic and type of binding).

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes (Pub No US 2002/0152238) as applied to claim 1 above, and further in view of Cordell (US Patent 6031989).

Hayes teaches the limitations of claim 1 for the reasons above.

For claim 2, Hayes does not teach “wherein said step of presenting said compound electronic document comprises the step of printing said document on a printer”.

Cordell teaches methods and systems to access and display nested HTML documents (see Abstract) in which he teaches “step of presenting said compound electronic document comprises the step of printing said document on a printer” (see Fig 1, item 20).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hayes by the teaching of Cordell, because printers are taught as output devices of computer systems (see Cordell, column 4, lines 43-46). This gives users the added advantage of receiving computer information on tangible computer papers.

For claim 5, Hayes does not teach “wherein said second document being a markup language document comprising a markup language control command adapted to bind a third electronic document into said first electronic document when activated by the user.”

Cordell teaches a new markup language control command to allow nesting of HTML and other electronic document within a main HTML document (see Abstract), in which he teaches a “second document being a markup language document comprising a markup language control command adapted to bind a third electronic into said first electronic document when activated by the user” (see Cordell, column 13, lines 3-21 and Fig 6A).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hayes by the teaching of Cordell, because comprising a markup language control command adapted to bind a third electronic into said first electronic document in a markup language document is a method of formatting and displaying nested documents more efficiently (see Abstract of Cordell).

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes (Pub No US 2002/0152238) as applied to claim 3 above, and further in view of World Wide Web Consortium

or W3C (HTML 4.01 Specification W3C Recommendation – 24 December 1999  
[<http://www.w3.org/TR/html4>]).

Hayes teaches the limitations of claim 1 for the reasons above.

Hayes does not teach “wherein said parameter specifying which parts of said second electronic document are to be embedded into said first document.”

W3C teaches HTML 4.01 Specification (see <http://www.w3.org/html4>), in which W3C teaches “wherein said parameter specifying which parts of said second electronic document are to be embedded into said first document” (see e.g., ‘a’ element and ‘name’ attribute in HTML 4.01 Specification. An ‘a’ element specifies a link (with ‘href’ attribute) and creates a named anchor around some part of the document (with ‘name’ attribute)).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hayes by the teaching of W3C, because using a “parameter specifying which parts of said second electronic document are to be embedded into said first document” gives users the ability to link information from one document to another more effectively.



*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong-Thao Cao whose telephone number is (571) 272-2735. The examiner can normally be reached on 8:30 AM - 5:00 PM (Mon - Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PTC

September 19, 2005



**ALFORD KINDRED  
PRIMARY EXAMINER**